

**This Opinion is Not a
Precedent of the TTAB**

Mailed: January 24, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Elisabeth Stecki DBA Whineware
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Serial No. 87215481
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Lori Boatright and Patrick B. Law of Loza & Loza, LLP for
Elisabeth Stecki DBA Whineware.

Ellen J. G. Perkins, Trademark Examining Attorney, Law Office 110,
Chris A. F. Pedersen, Managing Attorney.

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Before Cataldo, Wellington, and Shaw,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Elisabeth Stecki DBA Whineware (“Applicant”) seeks registration on the Principal Register of the standard character mark **TSA-KIT** for “Bottles, sold empty” in International Class 21.¹

¹ Application Serial No. 87215481, filed on October 25, 2016, based on Applicant’s allegation of a first use anywhere and in commerce on October 9, 2016, under Trademark Act Section 1(a), 15 U.S.C. § 1051(a). The application, as filed, showed the mark “TSA Kit TSA-Kit”; a substitute drawing for the mark TSA-KIT was filed by Applicant on November 1, 2016, and the application was amended accordingly.

The Trademark Examining Attorney has refused registration of Applicant's mark on the ground that it may falsely suggest a connection with the U.S. Department of Homeland Security Transportation Security Administration ("TSA"), under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a).

When the refusal was made final, Applicant requested reconsideration and filed an appeal. The Examining Attorney denied the request for reconsideration and the appeal has been briefed.² For the following reasons, we affirm the refusal.

I. False Suggestion of a Connection

Section 2(a), in relevant part, prohibits registration of "matter which may... falsely suggest a connection with persons, living or dead, institutions, beliefs or national symbols..." 15 U.S.C. § 1052(a). As applied to this case, the Examining Attorney must show that: (1) Applicant's mark is the same as, or a close approximation of, the name or identity previously used by another person or institution, in this case TSA; (2) Applicant's mark would be recognized as such, in that it points uniquely and unmistakably to TSA; (3) TSA is not connected with the goods offered by Applicant under the mark; and (4) the fame or reputation of TSA is such that, when Applicant's mark is used with Applicant's goods, a connection with TSA would be presumed. *In re Pedersen*, 109 USPQ 2d 1185, 1188-89 (TTAB 2013); *In re Jackson Int'l Trading Co.*, 103 USPQ2d 1417, 1419 (TTAB 2012); *see also Univ.*

² In her appeal brief (10 TTABVUE 3-4), Applicant notes that the Examining Attorney referenced "issues regarding descriptiveness" in the Office Action (issued May 8, 2018) denying the request for reconsideration. However, as the Examining Attorney explained in her brief (12 TTABVUE 4), this was an inadvertency and the sole issue on appeal is the false suggestion of a connection ground for refusal.

of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co., 703 F.2d 1372, 1375-77, 217 USPQ 505, 508-10 (Fed. Cir. 1983) (providing the foundational principles for the current four-part test used to determine the existence of a false suggestion of connection).

It is well established that government agencies fall within the scope of such protectable “persons,” for purposes of Section 2(a)’s prohibition of marks that may falsely suggestion a connection. *See, e.g., In re Peter S. Herrick, P.A.*, 91 USPQ2d 1505 (TTAB 2009); *NASA v. Record Chem. Co. Inc.*, 185 USPQ 563 (TTAB 1975). Indeed, the Trademark Manual of Examining Procedure (TMEP) instructs examining attorneys that “[r]egistration of matter that may falsely suggest a connection with a United States government agency or instrumentality is prohibited under § 2(a).” TMEP § 1203.02(c)(ii) (October 2018).

In our determination whether Applicant’s mark may falsely suggest a connection with TSA, it is important to keep in mind that the rationale behind this Section 2(a) ground differs significantly from the Section 2(d) ground of likelihood of confusion. As Professor McCarthy points out, albeit in an inter partes context, “[t]he issue in a § 2(a) case is not whether consumers would believe that the defendant’s goods emanate from the plaintiff [but] whether consumers would falsely assume the goods had some connection with plaintiff.” 3 McCarthy on Trademarks and Unfair Competition § 19:76 (5th ed. 2017). While the likelihood of confusion ground is designed to protect the public from confusion as to the source of goods or services, the

Federal Circuit has noted that the interests being protected by way of the Section 2(a) false suggestion of a connection ground are different:

[T]he rights protected under the § 2(a) false suggestion provision are not designed primarily to protect the public, but to protect persons and institutions from exploitation of their persona.

Bridgestone/Firestone Research Inc. v. Auto. Club de l'Ouest de la France, 245 F.3d 1359, 58 USPQ2d 1460, 1463-64 (Fed. Cir. 2001), citing to *University of Notre Dame*, 217 USPQ at 508–09 (“[I]t appears that the drafters sought by § 2(a) to embrace concepts of the right to privacy,” even in the absence of likelihood of confusion); see also *In re MC MC S.r.l.*, 88 USPQ2d 1378, 1380 (TTAB 2008).

We now apply the four-part test used to determine the existence of a false suggestion of connection to the facts of this appeal.

1. TSA-KIT is the same as or a close approximation of TSA

The record shows that the Transportation Security Administration is formally and informally abbreviated to “TSA,” and is a sub agency of the U.S. Department of Homeland Security.³ TSA was created “in the wake of 9/11” and “vets 100 percent of all passengers into, out of, and with the United States.”⁴

³ From the U.S. government website, www.dhs.gov, printouts attached to Office Action issued on February 13, 2017, at TSDR p. 3-4. This frequent use of the abbreviation TSA is also evidenced in the U.S. government website www.tsa.gov printouts attached to Applicant’s response filed on August 3, 2017.

⁴ Id.

We find the mark TSA-KIT is clearly a close approximation of TSA. The mark contains the agency’s name followed by –KIT; the latter element merely describes the manner in which the goods are being sold, i.e. as a kit.⁵

2. TSA-KIT will be recognized as pointing uniquely and unmistakably to TSA

Applicant seeks registration of TSA-KIT for “bottles, sold empty.” As the record amply demonstrates, certain travel goods, including goods very similar to Applicant’s, are sold by third parties and advertised as being compliant with TSA travel regulations.⁶ For example:



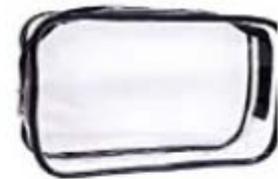
MoDA TSA Compliant 10 In
1 Travel Bottle Set Multi

7



NEW TSA 3 DIAL
COMBINATION LUGGAGE

8



TSA Compliant Clear Carry-
On Travel Toiletry Bag

9

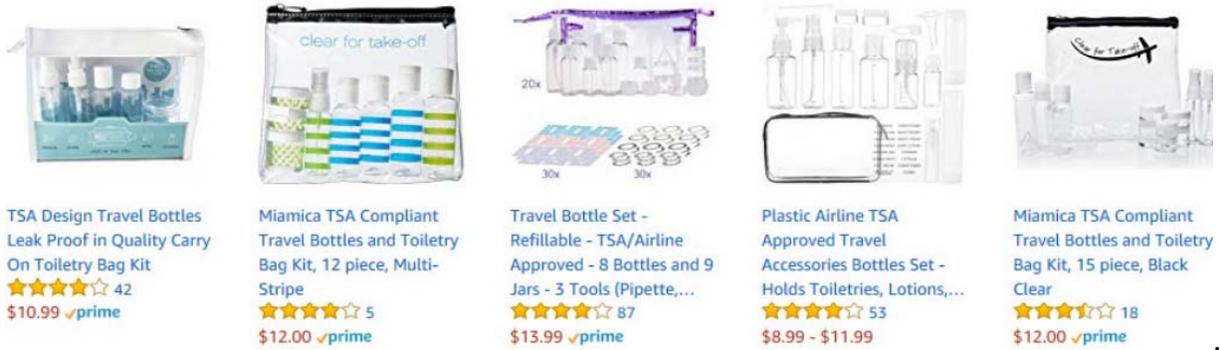
⁵ Applicant’s own website describes her goods as a “kit” that includes bottles, funnel, towel, etc. Printout attached to February 13, 2017 Office Action, TSDR p. 8.

⁶ Internet printouts from various retail websites depicting the goods are attached to Office Actions issued on February 13, 2017 and May 8, 2018. Applicant also submitted similar internet evidence with her response filed August 13, 2017 and the request for reconsideration filed on March 14, 2018.

⁷ February 13, 2017 Office Action, TSDR p. 6.

⁸ Id.

⁹ Id. at p. 7.



.10

Indeed, Applicant highlights one feature of her bottles is that they meet the TSA “standard for contents allowable by law”:

THE AVERAGE COST FOR A DRINK AT AIRPORT BARS IS \$12.99! USE TSA-KITS TO CARRY YOUR FAVORITE DRINK TO THE AIRPORT

ORIGINAL KIT INCLUDES

- FIVE, DISHWASHER SAFE, ORGANIC PRINT 2 OZ GLASS BOTTLES
- FUNNEL TO HELP POUR YOUR FAVORITE SPIRIT
- MICROFIBER TOWEL TO CLEAN UP SPILLS
- TRANSPARENT WATER RESISTANT BAGS TO VIEW YOUR FILLED BOTTLES

TSA-KITS ARE COMPATIBLE WITH TSA POLICY LIQUID CARRY-ON REGULATIONS

.11

This evidence overwhelmingly supports the finding that Applicant’s mark will be understood by consumers as pointing uniquely and unmistakably to the government agency, the TSA. Consumers will immediately understand the significance of this reference in Applicant’s mark.

¹⁰ May 8, 2018 Office Action, TSDR p. 10.

¹¹ Id. at pp. 8-9.

Applicant acknowledges the aforementioned evidence and that it shows “sellers of personal products routinely needed while traveling sell products called ‘TSA Safe,’ ‘TSA Friendly’ or ‘TSA Compliant’ to state that the size/nature meets with TSA rules, be it amounts of liquids, transparency of cosmetic holders, or approved alcohol allotments.” Applicant concludes “[t]hese are commonly understood meanings to which the TSA does not object.” However, the third-party use of TSA to provide information about its goods appears to be just that – for informational use in connection with the goods. Applicant, on the other hand, seeks to adopt TSA as part of her mark and, in doing so, the implication is that TSA has some affiliation with Applicant. Consumers may falsely believe TSA has some connection with the goods; for example, consumers may believe, incorrectly, that TSA has specifically approved Applicant’s goods or has certified the goods as being compliant with its regulations.

Applicant also argues:

There is no question that Applicant’s mark is a “play” on the acronym TSA – and that the purchasing public “knows” that TSA in the particular context references “the TSA” even as it knows that the TSA neither sells nor sponsors novelty products. Logic suggests that the TSA would be even less inclined to sell Applicant’s product in that TSA-KIT is actively marketed as, and the packaging states, that the bottles are for “Travel Sufficient Alcohol.” Applicant would argue that “TSA” is more aptly understood to reference the myriad of rules air travelers must abide by to comply with “TSA” requirements, but ultimately Applicant concedes the TSA reference for this purpose. Where the Applicant and “the Office” disagree is on one salient and critical issue: Applicant’s mark does not falsely suggest a connection to the TSA.

Contrary to Applicant’s argument, there is no evidence to suggest that anyone encountering Applicant’s mark, by itself, in connection with the identified goods would understand TSA to mean “travel sufficient alcohol.” Although Applicant may

in fact advertise the goods as being used for carrying alcohol or include that phrase on its packaging, the phrase “travel sufficient alcohol” is not part of the applied-for mark. We cannot assume that the phrase “travel sufficient alcohol,” will always appear on the goods, or packaging or advertisements for the goods. Nor is there any evidence to suggest that consumers are already familiar with TSA being an abbreviation for “travel sufficient alcohol.” Consequently, Applicant’s argument that her mark would be perceived as a “parody” is without support and is not persuasive.

Applicant’s contention that the “purchasing public” is aware “that the TSA neither sells nor sponsors novelty products” also misses the point. As already stated, there is no need that TSA make or sell related goods; rather, the issue is whether consumers would assume the bottles have some connection with plaintiff. Because TSA is uniquely involved in the regulation of what may be legally transported by travelers, it is likely that the inclusion of TSA in Applicant’s mark on goods designed to comply with TSA’s regulations will falsely suggest a connection with the governmental agency. Even if consumers do not mistakenly believe that TSA is the actual source or manufacturer of the goods, the inclusion of TSA in the applied-for mark may falsely suggest an affiliation between TSA and Applicant, or that TSA has formally approved or certified the goods as being compliant with TSA’s regulations.

The circumstances in this appeal are thus readily distinguishable from those in *FBI v. Societe: M. Bril & Co.*, 172 USPQ 310 (TTAB 1971), a decision cited by Applicant in her brief. In *FBI*, although the Board found it would be “unreasonable” for consumers to believe that Applicant’s clothing bearing the mark FBI

FABRICATION BRIL INTERNATIONAL would be associated with the Federal Bureau of Investigation (FBI), the Board observed that it was “most significant” that consumers would encounter the entire mark and that the latter three elements of the mark “serve[] to explain how the letters ‘FBI’ were conceived by applicant.” *Id.* at 315. In the matter at hand, there are no additional elements in Applicant’s mark to offer an alternative meaning of TSA and, for the reasons given above, it would not be “unreasonable” for consumers to assume that TSA is associated with empty bottles used for storing liquids when traveling.

3. TSA is not connected with the goods offered by Applicant and TSA’s fame is such that a connection with TSA would be presumed.

As to the remaining two criteria for finding false suggestion of a connection, there is no dispute that TSA is not connected with Applicant or the goods offered by Applicant under the mark. Moreover, there is no dispute as to the fame or reputation of TSA such that a connection would be presumed. Indeed, the evidence shows that TSA is well-recognized abbreviation for the governmental agency, particularly in the travel-related goods industry.

Because Applicant has no connection with TSA, her reliance on the Board’s decision in *In re Los Angeles Police Revolver and Athletic Club Inc.*, 69 USPQ2d (TTAB 2003) is misplaced. In that decision, the Board did not find a false suggestion of a connection when the applicant in that case sought to register TO PROTECT AND SERVE, the official motto used of the Los Angeles Police Department’s (LAPD), because “the evidence suggests that there is a substantial commercial connection between applicant and the LAPD.” *Id.* at 1633. In other words, the Board did not

make the necessary conclusion with respect to the criteria involving no actual connection between the applicant and the LAPD. In this case, however, there is no evidence to suggest that Applicant has an actual connection with TSA other than selling goods that comply with TSA's regulations.

In conclusion, Applicant's mark points uniquely to TSA and would be so recognized; TSA is not connected with Applicant or the goods being sold under the mark; and the fame or reputation of TSA is such that when Applicant's TSA-KIT mark is used with her goods, such a connection would be presumed.

Decision: The refusal to register Applicant's mark because it falsely suggests a connection with TSA is affirmed.